

Office Action Summary

Application No.

10/827,185

Applicant(s)

MUSGRAVE ET AL.

Examiner

RIP A. LEE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 20, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-9, 11-18, 20-24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-18, 20-24, and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action follows a response filed on November 20, 2007. Claims 1, 12, 21, 27, 31-34 were amended. Claims 1, 3-9, 11-18, 20-24, and 26-34 are pending.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3-9, 11-18, 20-24, and 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su *et al.* (U.S. 7,078,463) in view of McCullough *et al.* (U.S. 6,015,854).

Su *et al.* discloses a biaxially oriented polypropylene film comprising up to 50 wt % of isotactic polypropylene containing impact copolymer (heterophasic copolymer with up to 30 wt % of ethylene-propylene rubber phase dispersed in polypropylene matrix, described in col. 5, lines 40-54; melt flow 1-10 g/10 min, see claim 2), 10-70 wt % of an alpha olefin-propylene random copolymer, and 10-70 wt % of a third component, which is a "minirandom" isotactic polypropylene-ethylene copolymer with an ethylene content of 0.2-0.8 wt % (col. 6, line 30). The reference discloses the resin blend only but does not describe additives, however, the inventors indicate that various modifications are readily apparent to those skilled in the art. The skilled artisan, then, recognizes that the composition is not commercially practical without incorporation of conventional additives.

McCullough *et al.* teaches that due to the heterophasic nature of propylene impact copolymer, it is common practice to incorporate dibenzylidene sorbitols as clarifying agent in the amount of 800-5000 ppm, with 1200-4000 ppm being a preferable range (col. 2, lines 55-66). It would have been obvious to one having ordinary skill in the art, having both references at hand to use clarifying agent as disclosed in McCullough *et al.* in the film composition of Su *et al.* in order to provide a clear film.

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The prior art is silent with respect to the physical properties of the composition and articles prepared therefrom. However, in light of the fact that the composition of the prior art is substantially the same as that described in the instant claims, a reasonable basis exists to believe that it exhibits substantially the same physical properties recited in the instant claims. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Response to Arguments

3. Applicant traverses the rejection of claims over Su *et al.* in view of McCullough *et al.* Applicant submits that the combination of references does not disclose the claimed product, in light of the amendment to the preamble of the claim. While it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising.” Further, the burden is on the applicant to show that the additional ingredients in the prior art, *i.e.*, 10+ wt % of an alpha olefin-propylene random copolymer, would in fact be excluded from the claims and that such ingredient would materially change the characteristics of the applicant’s invention, such as haze and energy to maximum load/energy after maximum load ratio. See MPEP § 2111.03. Accordingly, the rejection of record has been maintained.

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Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu S. Jagannathan, can be reached at (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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February 4, 2008